

REMARKS

In the Examiner's Answer mailed June 28, 2002, the Examiner withdrew her rejection of Claims 1-7 and 9 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 5,714,428 issued to Le-Khac et al. and her rejection of Claim 9 under 35 U.S.C. §112. However, in that same Answer, the Examiner maintained her rejection of Claims 1-7 and 9 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al. The Board, in its Decision mailed April 23, 2003, upheld the Examiner's rejections under 35 U.S.C. §103(a).

Applicants confirm the correctness of the Examiner's presumption at page 4, first full paragraph, of the Final Office Action, mailed November 29, 2001, (and the paragraph numbered 10 pages 3-4 of the Examiner's Answer) regarding ownership of the presently claimed subject matter.

Rejections under 35 U.S.C. §103(a)

Claims 1-7 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al. Applicants respectfully disagree with the Examiner's contention regarding Le-Khac et al.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition given in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) that,

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, **the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.** (Emphasis added).

Applicants respectfully contend that the Examiner has failed to do so in the Final Office Action or in the Examiner's Answer. The claims as instantly amended are limited to a catalyst containing 2 to 80 wt. %, based on the amount of finished catalyst, of an aliphatic polycarbonate having a hydroxyl end group and an average molecular weight below 12,000, as determined by measurement of the OH number.

Such limitation finds support in at least page 5, line 30 – page 6 line 3 of the instant specification. As the Examiner has maintained, and the Board has confirmed, Le-Khac et al., at col. 4-5, teach the use of "polycarbonate."

Applicants contend Le-Khac et al. only provide a listing of functionalized polymer categories that they deem suitable in their "other preferred catalysts of the invention..." (col. 4, line 66), with the preferred functionalized polymers being disclosed at col. 4, lines 29-65. Therefore, applicants submit that Le-Khac et al. provide neither guidance nor suggestion of the claimed catalyst containing an aliphatic polycarbonate having a hydroxyl end group and an average molecular weight below 12,000, as determined by measurement of the OH number. Further, Le-Khac et al. provide no example of any polycarbonate-containing catalyst.

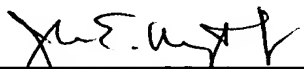
Therefore, applicants contend that nothing in the teaching of Le-Khac et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-7 and 9 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al.

Conclusion

Applicants have amended Claims 1 and 4-7 and have added Claim 10. Applicants contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-7, 9 and 10. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is requested to contact the applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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